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| 10/552,027   | 10/03/2005  | Theodorus Suibertus Anthonius Rolf | P/1336-199          | 6889             |
| 2352 7590 02/25/2010<br>OSTROLENK FABER GERB & SOFFEN<br>1180 AVENUE OF THE AMERICAS<br>NEW YORK, NY 100368403 |             |                                    |                     |                  |
| EXAMINER<br>KLAYMAN, AMIR ARIE   |             |                                    |                     |                  |
| ART UNIT<br>3711   |             | PAPER NUMBER                       |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/552,027

**Applicant(s)**ROLF, THEODORUS SUIBERTUS  
ANTHONIUS**Examiner**

AMIR KLAYMAN

**Art Unit**

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/3/05, 8/06/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: page 1 In 4-9 discloses claims 1, 11 and 14 which have been cancelled. Page 2, In 4-5 discloses claim 1 which has been canceled. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 17-20, 22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Nielsen US D384994.

Nielsen teaches a toy building block (see title) having a stud on the top surface in figs 1-5 and 7; the building block has a recess in the bottom surface as shown in fig 6. The stud has a cross-section like tooth-wheels configuration having rounded teeth and rounded grooves in figs 1 and 7.

As per claim 17, Nielsen discloses a toy building block in the title, comprising:

at least one stud on a top surface having cross-section like tooth-wheels configuration having rounded teeth and rounded grooves in figs 1 and 7;

at least one recess in the bottom surface, wherein the recesses have sidewalls providing an extending land shaped complementary to the grooves as can seen in fig 6.

As per claims 18, 19, Nielsen teaches that the recess has four lands in fig 6; wherein the cross-section like recess having the lands constitute the majority of the land while guiding a stud to be fitted into the recess.

As per claim 20, Nielsen discloses the stud shows a rotational symmetry of 4 in figs 1 and 7.

As per claim 22, Nielsen teaches that the building block is a cubic building block in figs 1-5. Examiner gives the broadest reasonable interpretation of the term cubic according to the dictionary. The definition of the term "cubic" is having three dimensions; solid. Thus, according the dictionary, Nielsen's building block is cubic.

As per claim 25, although Nielsen is silent regarding the process of manufacturing the blocks, examiner notes that it has been held that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even

though the prior product was made by a different process. See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385, 1395-97 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as laid down in *Graham*. Exemplary rationales that may support a conclusion of obviousness include:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) " Obvious to try " – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

5. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen US D384994 as applied to claim 17 above, and further in view of Bretting US 3487579, Rolf D564044 and Mott US 5938497.

As per claim 21, Nielsen is silent regarding a rotational symmetry of the stud is 6, 8, or 12.

In the field of building blocks and toy building blocks Bretting teaches a stud 25 with a rotational symmetry of 6; Rolf teaches a stud having a rotational symmetry of 8 in figs 1-2 and 7; and Mott teaches a stud 30 having a rotational symmetry of 12 in fig 4.

It would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Nielsen and to provide a rotational symmetry of the stud as 6, 8, or 12 as taught by Bretting, Rolf, and Mott respectively for the reason that a skilled artisan would have been motivated in providing a simple substitution of one known element for another to obtain the predictable results of having a stud with a rotational symmetry in order to be fitted into a suitable recess.

6. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen US D384994 as applied to claim 17 above, and further in view of Dehm US 3233358.

As per claim 23, Nielsen does not disclose that the stud and the recess have a pass-through hole to allow a screw to pass through.

In the field of toy building block, Dehm teaches a building block 11 having a stud (construed as web 15) with a hole 13 passing through the web (e.g. stud) and the recess as seen in figs 1 and 2. Figs 6 and 8 are showing the use of connecting element axle 22 with cups 23 and/or 24 to fasten two building blocks one to another.

With respect to a screw may be passed through the construction block, Dehm's structure is fully capable of receiving the well known screw to connect/fasten the building blocks one to another instead of the axle and the cup.

As per claim 24, the area around stud 15 for receiving cups 23 and/or 24 as shown in figs 6 and 8 in the reference to Dehm, is construed as the enlargement area within the stud for receiving a head of a screw as recited. As examiner discussed above in claim 23, Dehm's structure is fully capable of receiving the well known screw instead the axle and the cup.

7. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen US D384994 as applied to claim 17 above, and further in view of De Pieri et al US 5471808.

As per claim 26, Nielsen does not disclose slots for holding construction devices.

In the field of building blocks, Pieri teaches a block 1 having edges (e.g. slots) 21, 25, 22, 24 to accommodate frame construction framework 23 in fig 3.

It would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Nielsen and to provide slots to hold construction devices there-within as taught by Pieri to obtain the predictable results of having slots capable of holding a construction device. See examiner recitation above regarding the Supreme Court decision in KSR that a skilled artisan would have been motivated to look for solutions and modifications in the same or different field to arrive at the claimed invention.

8. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen US D384994 as applied to claim 17 above, and further in view of Garpow US 6506091.

As per claim 27, Nielsen is silent regarding a bivalent block having only recesses and at least one stud.



In the field of toy building blocks, Garpow teaches a bivalent block 10 with only recess 47 and male connectors (e.g. studs) 40, 50, and 60 in fig 3; fig 5 shows the use of the studs to be inserted in the recesses of another bivalent block.

With respect to the stud being double its length, examiner notes that it has been held that claims which fall within the broad scope of the references are unpatentable there over because, among other reasons, there is no evidence of the criticality of the claimed ranges of weight or proportions; see *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809(CCPA 1969). Applicant needs to provide evidence that the stud must be double its size in order to critically form applicant's invention. What distinguishes a stud that is double its size from a stud that is less than double its length or more than a double its length?

With respect to making the stud separable from the building block, examiner notes that it has been held that the use of a one piece construction instead of the use of separable elements would be merely a matter of obvious engineering choice. See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to make the stud separable in *Nielsen* for the reason that making parts separable would be merely a matter of obvious engineering choice where a skilled artisan would have been motivated to choose to make an integral part into a plurality of separate parts.

9. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen US D384994 in view Dehm US 3233358 as applied to claim 23 above, and further in view of Lindenmeyer US 2609638.

As per claims 28, the modified Nielsen is silent regarding a screw having a first thread on the screw's body within its terminal section and second inner thread in the screw's head.

In the field of toy connectors, Lindenmeyer teaches a screw (studs 22 and 22') having a first thread (13) on the screw's body within its terminal section and second inner thread (18") in the screw's head in figs 7 and 16; see also figs 14-15 and col 5, ln 18-36.

It would have been obvious at the time the invention was made to one of ordinary skill in the art to modify the combination Nielsen & Dehm and to provide a screw having a first thread on the screw's body and second inner thread in the screw's head as taught by Lindenmeyer to obtain the predictable results of having a screw to fastened building blocks one to another in forming a building block construction. See examiner recitation above regarding the Supreme Court decision in KSR that a skilled artisan would have been motivated to look for solutions and modifications in the same or different field to arrive at the claimed invention.

As per claim 29, the modified Nielsen having the screw with a first thread on the screw's body and second inner thread in the screw's head as taught by Lindenmeyer,

would have replaced the axle and cup (as taught by the reference to Dehm) of the modified Nielsen.

The modified Nielsen having a building block with a hole passing through the stud and the recess to receive a screw; the screw having a first thread on its body and second inner thread in its head.

With respect to the use of a tool may be interested and rotationally fixed in the head, a tool/screwdriver is fully capable of inserting in the head as claimed.

As per claim 30, Nielsen discloses cross-section of the recess has at least four crests in fig 6.

10. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen US D384994 in view Dehm US 3233358 and Lindenmeyer US 2609638 as applied to claim 28 above, and further in view of Deahr US 5498188.

As per claim 31 the modified Nelsen is silent regarding a screwdriver.

In the field of toy building structure, Deahr teaches a toy building structure 10 in fig 1 and a screwdriver 124 in fig 4.

It would have been obvious at the time the invention was made to one of ordinary skill in the art to provide the modified Nelsen a screwdriver as taught by Deahr to obtain the predictable results of using the well known screwdriver to insert the screw within the threaded hole.

11. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen US D384994 in view of Dehm US 3233358 as applied to claim 23 above, and further in view of Garpow US 6506091.

As per claim 32, the combination Nielsen & Dehm does not disclose the use of a third thread within a hole so that a screw may be screwed there-through.

In the field of toy building blocks, Garpow teaches a thread 46 within a hole to allow a screw (male connector with thread 45) to fit within as shown in fig 3.

It would have been obvious at the time the invention was made to one of ordinary skill in the art to make the stud separable in the modified Nielsen for the reasons discussed in claim 27 above. In order to fit the separable stud having a threaded body within the recess, the recess hole must be threaded as well.

Furthermore, providing the well known thread within a hole so that a screw can be screwed there-through would have been obvious to one of ordinary skill in the art for the reason that the predictable results of fastening two elements one to another by using a screw screwed within a hole having a thread are being obtained.

As per claim 33, the area around stud 15 for receiving cups 23 and 24 as shown in figs 6 and 8 in the reference to Dehm is construed as the enlargement area within the stud for receiving a head of a screw as recited. As examiner discussed above in claim 23, it would have been obvious to replace axle 22 and cups 23, 24 in Dehm with the

well known screw; wherein the screw's head is received within an enlargement of the stud 15 instead of cup 23 or cup 24.

12. Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen US D384994 in view Dehm US 3233358 and Lindenmeyer US 2609638 as applied to claim 28 above, and further in view of Garpow US 6506091.

As per claims 34, 35 Lindenmeyer's studs (e.g. screws) 22 and 22', as seen in figs 7 and 16 respectfully, have a middle threaded portion 17" (e.g. the fourth threaded part); wherein the modified Nielsen has a bivalent block with threaded hole (e.g. the third thread) to allow a screw (male connector with thread 45) to fit within as shown in fig 3 in the reference to Garpow; and a screw (studs 22 and 22') having a first thread on the screw's body (13) and second inner thread (18") in the screw's head as shown in the reference to Lindenmeyer in figs 7 and 16; see also figs 14-15 and col 5, ln 18-36.

In order to construct the modified Nielsen building assembly, the fourth threaded portion (on the screw's body) must be fitted within the threaded hole (e.g. the third thread) to form a united formation; thus, to allow the fastening of one block with another block.

With respect to the first thread having a smaller diameter than the fourth thread; Lindenmeyer discloses the first thread (13) on the terminal section of the screw has a

smaller diameter than the screw's middle portion 17" (e.g. the fourth thread) in figs 7 and 16.

With respect to a shaped tool's end may be interested and rotationally fixed in the head, a tool is fully capable of inserting in the head as claimed.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMIR KLAYMAN whose telephone number is (571)270-7131. The examiner can normally be reached on Mo. - Fr. (7:30AM-5:00PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene KIM can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Gene Kim/

Supervisory Patent Examiner, Art Unit 3711